

### **REMARKS**

Claims 1, 22, 80, 91, 96, 100, 102 and 103 have been amended.

Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97, and 99-103 are pending.

Applicants thank the Examiner for withdrawing the previous rejections under 35 U.S.C. § 102(b). See Office Action at p. 2.

### **CLAIM REJECTIONS**

#### ***Rejection of claims under 35 U.S.C. § 112***

The Examiner has rejected claims 96, 100 and 101 under 35 U.S.C. § 112, second paragraph, as being indefinite. See Office Action at p. 2. Specifically, the Examiner states that claims 96 and 100 lack antecedent basis for the term "hydroxyl" in the claims. Claim 101 has been rejected as it is dependent on claim 100. See Office Action at p. 3. Applicants have amended claims 96 and 100 to delete the reference to term "hydroxyl." Applicants respectfully request the withdrawal of this rejection with respect to claims 96, 100 and 101.

#### ***Rejection of claims under 35 U.S.C. §102(b)***

##### ***Baker***

The Examiner has rejected claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-90 and 102 under 35 U.S.C § 102(b) as being anticipated by U.S. Patent No. 4,513,005 to Baker et al. ("Baker"). See Office Action at p. 3. Claims 2-5, 7, 8, 12, 13, 16 and 17 depend from independent claim 1. Claims 25 and 26 depend from independent claim 22. Claims 81-90 depend from independent claim 80. Claim 102 is an independent claim.

The Examiner contends that "Baker discloses ... the compound (E) 8-phenyl-5-octenoic acid and its sodium salt in aqueous solution corresponding to a pharmaceutical composition." See Office Action at p. 3. The Examiner further states that "8-phenyl-5-octenoic acid corresponds to instantly claimed compounds in which A is phenyl (unsubstituted), L is a C<sub>8</sub> trans olefin<sup>1</sup>, Y<sub>1</sub>, Y<sub>2</sub>=bond (or L is a C<sub>6</sub> all trans diene, Y<sub>1</sub>, Y<sub>2</sub>=CH<sub>2</sub>), X<sub>1</sub>, X<sub>2</sub>=O." *Id.* In independent claims 1, 22, 80 and 102, when L is C<sub>3-7</sub> and contains one triple bond or one or two double bonds and A is phenyl or substituted phenyl, Y<sup>1</sup> is not a bond or -CH<sub>2</sub>-, and Y<sup>2</sup> is -CH<sub>2</sub>-. As such, the

---

<sup>1</sup> There appears to be a typographical error here in this characterization of L. L should refer to a C<sub>7</sub> trans olefin. Applicants invite the Examiner to clarify this statement regarding the L group.

compounds described in Baker are not within the scope of amended claims 1, 22, 80 and 102.

Accordingly, independent claims 1, 22, 80 and 102 and claims that depend therefrom are not anticipated by Baker for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

***Howden***

The Examiner has rejected claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-90, 91-94, 96, 97 and 99-103 under 35 U.S.C. § 102(b) as being anticipated by Howden et al. (*Journal of the American Chemical Society*, Vol. 88(8), pages 1732-1742 (1966) ("Howden")). See Office Action at p. 4. Claims 2-5, 7, 8, 12, 13, 16 and 17 depend from independent claim 1. Claims 25 and 26 depend from independent claim 22. Claims 81-90 depend from independent claim 80. Claims 92-94, 96, 97, 99-101 depend from independent claim 91. Claims 102 and 103 are independent claims.

The Examiner contends that "Howden discloses ... the compound 5, 5-diphenylpent-4-enoic acid and its aqueous solution as a salt corresponding to a pharmaceutical composition." *Id.* The Examiner additionally states that "5, 5-diphenylpent-4-enoic acid corresponds to an instantly claimed compound in which A is phenyl (unsubstituted), L is a C4 mono alkene substituted with monocyclic aryl, Y<sub>1</sub>, Y<sub>2</sub>=bond and X<sub>1</sub>, X<sub>2</sub>=O." *Id.* In independent claims 1, 22, 80, 91, 102 and 103, when L is C<sub>3-7</sub> and contains one triple bond or one or two double bonds and A is phenyl or substituted phenyl, Y<sup>1</sup> is not a bond or -CH<sub>2</sub>-, and Y<sup>2</sup> is -CH<sub>2</sub>-. As such, the compounds described in Baker are not within the scope of amended claims 1, 22, 80, 91, 102 and 103.

Accordingly, independent claims 1, 22, 80, 91, 102 and 103 and claims that depend therefrom are not anticipated by Howden for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

Applicant : Hsuan-Yin Lan-Hargest et al.  
Serial No. : 10/025,947  
Filed : December 26, 2001  
Page : 15 of 15


Attorney's Docket No.: 15128.0003

### CONCLUSION

Applicants believe that the claims now pending are in condition for allowance. Should any fees be required by the present Amendment, the Director is hereby authorized to charge Deposit Account **19-4293**.

Respectfully submitted,

Date: 3-16-09  
**Customer No. 27890**  
Steptoe & Johnson LLP  
1330 Connecticut Avenue, NW  
Washington, DC 20036-1795  
Phone: 202-429-6748  
Fax: 202-429-3902

  
\_\_\_\_\_  
Harold H. Fox  
Reg. No. 41,498